

**REMARKS**

Claim 1 is amended to recite that the stretched porous resin film is "self-supporting", as supported by the specification, for example, on page 24, lines 5-6. No new matter is presented.

Entry of the Amendment is proper after final rejection since the amendment to claim 1 is being made in response to the Examiner's statement that the claims do not recite the feature of a "*self-supporting* stretched porous resin film" as mentioned in the arguments presented in the Response filed on September 20, 2005. Further, the amendment is believed to place the claims in condition for allowance.

Upon entry of the Amendment, which is respectfully requested, claims 1-6, 8-11 and 13-21 will be all the claims pending in the application.

**I. Response to Claim Rejections**

Claims 1-6, 8-11 and 13-19 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over WO 99/46117.

Claim 11 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over WO 99/46117 as applied to claim 1 above, and further in view of JP 07-195827.

Applicants respectfully submit that the cited references do not disclose, teach or suggest the presently claimed invention, whether taken alone or in combination.

As noted above, claim 1 is amended to recite that the stretched porous resin film is "self-supporting", as supported by the present specification, for example, on page 24, lines 5-6.

The Examiner's position is that the powdery composition of Arai et al meets the claimed invention. In this regard it is essentially the Examiner's position that the features of a "self-supporting" and/or a "stretched" film are inherent in the powdery composition of Arai et al. However, inherency may not be established by probabilities or possibilities that a certain property or characteristic might be achieved if certain conditions are optimized. To establish inherency, the evidence must make it clear that the characteristic or property is necessarily present in the prior art. See MPEP § 2112(IV). Further, the Examiner has the initial burden to provide a reasonable basis for asserting that the claim elements are met by the prior art and the fact that Arai et al does not exclude the powdery composition from being self-supporting does not necessarily mean that it is a self-supporting film. Similarly, since the term "stretched" is a positive distinguishing element of the claims, the burden shifts to the Examiner to provide a reasonable basis for asserting that the powdery coating composition of Arai et al meets the element of the presently claimed invention.

Applicants respectfully submit that the Examiner has not met this burden. As previously pointed out, the resin powdery composition of Arai et al (Example 10) cannot form an independent self-supporting ink-receiving layer and is completely different from the stretched porous resin film of the present invention. That is, the ink-receiving layer of Arai et al (Example 10) formed on an ordinary paper is completely different from the self-supporting stretched porous resin film of the present invention formed from the composition recited in the present claims. The composition of the present invention is kneaded in an intermeshing twin-screw extruder at a screw shear rate of  $300 \text{ sec}^{-1}$  to produce a porous resin film and the porous resin film is stretched. The self-supporting stretched porous resin film of the claimed invention is

capable of being used alone or may be combined to form a laminate. See, e.g., page 24, lines 5-8 of the specification. Thus, the terms "self-supporting", "film" and "stretched" in the present claims define structural and physical elements of the claimed invention that distinguish it from the ink-receiving layer of Arai et al. The ink-receiving layer of Arai et al said to correspond to the stretched porous resin film of the present invention cannot be self-supporting or stretched and does not form a film within the scope of the present invention. Therefore, the claimed invention as recited in independent claim 1 is not anticipated by Arai et al.

In addition, Arai et al does not teach or suggest a stretched porous resin film as recited in independent claim 1 of the present invention and there is no motivation for one of ordinary skill in the art to modify the disclosure of Arai et al with a reasonable expectation of success in achieving the claimed invention. Thus, the claimed invention is not rendered obvious.

With respect to the rejection of claim 11 over Arai et al in view of JP '827, JP '827 does not remedy the deficiencies of Arai et al as discussed above. Specifically, JP '827 also fails to disclose, teach or suggest a self-supporting stretched porous resin film as claimed. Thus, one of ordinary skill in the art would not have been motivated to combine the references with a reasonable expectation of achieving the claimed invention. Even if combined, the present invention would not have been achieved since neither of the references teaches a self-supporting stretched porous resin film within the scope of the present invention.

Further, Arai et al does not describe the invention recited in claims 20 and 21 of the present application, which depend from independent claim 1.

In view of the above, the claimed invention is not anticipated nor rendered obvious by the cited references. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102 and/or 35 U.S.C. § 103.

## **II. Allowable Subject Matter**

Claims 20 and 21 are indicated as containing allowable subject matter. Claims 20 and 21 depend from claim 1, and are distinguished over the art for at least the same reasons.

Accordingly, Applicants respectfully request withdrawal of the objection to claims 20 and 21.

## **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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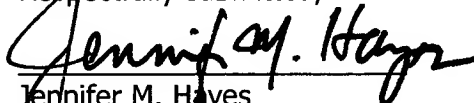
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